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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,952	10/22/2003	Michael J. Wookey	30014200-1103	6437

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EXAMINER

BONURA, TIMOTHY M

ART UNIT	PAPER NUMBER
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2114

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/690,952	Applicant(s) WOOKEY, MICHAEL J.	
	Examiner Tim Bonura	Art Unit 2114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 9,25 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,10,11,17-19,22,24,26,27,33-35,38-40,42,43 and 49 is/are rejected.
- 7) ☒ Claim(s) 4,5,12-16,20,21,28-32,36,37 and 44-48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- **Claims 1-2, 17-18, and 33-34 provisionally rejected on the ground of nonstatutory obviousness-type double patenting**
- **Claims 1-3, 6-8, 10-11, 17-19, 22-24, 26-27, 33-35, 38-40, 42-43, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Atallah, et al, U.S. Patent Publication Number 2004/0054946.**
- **Claim 4-5, 12-16, 20-21, 28-32, 36-37, 44-48 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims**

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-2, 17-18, and 33-34 provisionally rejected judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1, 11 and 22 (respectively) of copending Application No. 10/690,951. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention to anticipate that claims 1 and 2 of the present application in view of in re Eli Lilly.

3. Claim 1 of U.S. patent application number 10/690951 (now patented, 11/22/2006) contain(s) every element of claims 1 and 2 of the instant application and as such anticipate(s) claim 1 and 2 of the instant application.

4. Claim 11 of U.S. patent application number 10/690951 (now patented, 11/22/2006) contain(s) every element of claims 17 and 18 of the instant application and as such anticipate(s) claim 17 and 18 of the instant application.

5. Claim 22 of U.S. patent application number 10/690951 (now patented, 11/22/2006) contain(s) every element of claims 33 and 34 of the instant application and as such anticipate(s) claim 33 and 34 of the instant application.

6. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001)

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 6-8, 10-11, 17-19, 22-24, 26-27, 33-35, 38-40, 42-43, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Atallah, et al, U.S. Patent Publication Number 2004/0054946.

9. Regarding claim 1:

a. Regarding the limitation of “asynchronously receiving information about a computer-based system by subscribing to the information,” Atallah discloses a system that can gather data and assess risk between a binary file and a software module. (Paragraph 0009).

b. Regarding the limitation of “calculating an exposure level to failure of the computer-based system based on the received information,” Atallah disclose a system wherein generating a risk of a binary compatibility failure between the file and the software module. (Paragraph 0009).

10. Regarding claim 2, Atallah discloses a system wherein risk assessment is downloaded to a subscriber. (Paragraph 0031).

11. Regarding claim 3, Atallah discloses a system wherein a calculation of a risk level is done using received information. (Paragraph 0031). Atallah also discloses a system wherein

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the returned value is based on a risk level (exposure level) and a compatibility level (confidence level) of the test. (Paragraph 0032 and 0039).

12. Regarding claim 6, Atallah disclose a system that can asynchronously receive risk assessment data on the Internet, download it, run it, and output the results of the assessment. (Paragraph 0027).

13. Regarding claim 7, Atallah disclose a system that can asynchronously receive risk assessment data on the internet, download it, run it, and output the results of the assessment. (Paragraph 0027). The risk level can be calculated and outputted. (Paragraph 0032).

14. Regarding claim 8, Atallah disclose that the method of failure prediction is a computer implemented computer program product. (Paragraph 0031).

15. Regarding claim 10, Atallah discloses that the results are communicated across a data path to a user interface. Thereby the transmission of the data is a across a network to the user interface. (Paragraph 0030).

16. Regarding claim 11, Atallah discloses a system with means for collecting data from software configurations. (Paragraph 0019).

17. Regarding claim 17:

c. Regarding the limitation of "asynchronously receiving information about a computer-based system by subscribing to the information," Atallah discloses a system that can gather data and assess risk between a binary file and a software module. (Paragraph 0009).

d. Regarding the limitation of "calculating an exposure level to failure of the computer-based system based on the received information," Atallah disclose a system wherein generating a risk of a binary compatibility failure between the file and the software module. (Paragraph 0009).

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18. Regarding claim 18, Atallah discloses a system wherein risk assessment is downloaded to a subscriber. (Paragraph 0031).

19. Regarding claim 19, Atallah discloses a system wherein a calculation of a risk level is done using received information. (Paragraph 0031). Atallah also discloses a system wherein the returned value is based on a risk level (exposure level) and a compatibility level (confidence level) of the test. (Paragraph 0032 and 0039).

20. Regarding claim 22, Atallah disclose a system that can asynchronously receive risk assessment data on the Internet, download it, run it, and output the results of the assessment. (Paragraph 0027).

21. Regarding claim 23, Atallah disclose a system that can asynchronously receive risk assessment data on the Internet, download it, run it, and output the results of the assessment. (Paragraph 0027). The risk level can be calculated and outputted. (Paragraph 0032).

22. Regarding claim 24, Atallah disclose that the method of failure prediction is a computer implemented computer program product. (Paragraph 0031).

23. Regarding claim 26, Atallah discloses that the results are communicated across a data path to a user interface. Thereby the transmission of the data is a across a network to the user interface. (Paragraph 0030).

24. Regarding claim 27, Atallah discloses a system with means for collecting data from software configurations. (Paragraph 0019).

25. Regarding claim 33:

e. Regarding the limitation of "asynchronously receiving information about a computer-based system by subscribing to the information," Atallah discloses a system that can gather data and assess risk between a binary file and a software module. (Paragraph 0009).

- f. Regarding the limitation of "calculating an exposure level to failure of the computer-based system based on the received information," Atallah disclose a system wherein generating a risk of a binary compatibility failure between the file and the software module. (Paragraph 0009).
26. Regarding claim 34, Atallah discloses a system wherein risk assessment is downloaded to a subscriber. (Paragraph 0031).
27. Regarding claim 35, Atallah discloses a system wherein a calculation of a risk level is done using received information. (Paragraph 0031). Atallah also discloses a system wherein the returned value is based on a risk level (exposure level) and a compatibility level (confidence level) of the test. (Paragraph 0032 and 0039).
28. Regarding claim 38, Atallah disclose a system that can asynchronously receive risk assessment data on the Internet, download it, run it, and output the results of the assessment. (Paragraph 0027).
29. Regarding claim 39, Atallah disclose a system that can asynchronously receive risk assessment data on the Internet, download it, run it, and output the results of the assessment. (Paragraph 0027). The risk level can be calculated and outputted. (Paragraph 0032).
30. Regarding claim 40, Atallah disclose that the method of failure prediction is a computer implemented computer program product. (Paragraph 0031).
31. Regarding claim 42, Atallah discloses that the results are communicated across a data path to a user interface. Thereby the transmission of the data is a across a network to the user interface. (Paragraph 0030).
32. Regarding claim 43, Atallah discloses a system with means for collecting data from software configurations. (Paragraph 0019).
33. Regarding claim 49:

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g. Regarding the limitation of "asynchronously receiving information about a computer-based system by subscribing to the information," Atallah discloses a system that can gather data and assess risk between a binary file and a software module. (Paragraph 0009).

34. Regarding the limitation of "calculating an exposure level to failure of the computer-based system based on the received information," Atallah disclose a system wherein generating a risk of a binary compatibility failure between the file and the software module. (Paragraph 0009).

Allowable Subject Matter

35. Claim 4-5, 12-16, 20-21, 28-32, 36-37, 44-48 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

36. Applicant's arguments filed 11/22/2006 have been fully considered but they are not persuasive.

37. Regarding the arguments concerning the double patenting rejection. The co-pending application has now been allow (12/05/2006). The double patenting rejections are hereby maintained.

38. Applicant's arguments with respect to claims 1-49 (art rejections) have been considered but are moot in view of the new ground(s) of rejection. See new rejections above.

Conclusion

39. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

40. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tim Bonura**.

- The examiner can normally be reached on **Mon-Fri: 8:30-5:00**.
- The examiner can be reached at: **571-272-3654**.

42. If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, **Scott Baderman**.

- The supervisor can be reached on **571-272-3644**.

43. The fax phone numbers for the organization where this application or proceeding is assigned are:

- **703-872-9306 for all patent related correspondence by FAX.**

44. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

45. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is: **571-272-2100**.

46. Responses should be mailed to:

- o **Commissioner of Patents and Trademarks**

P.O. Box 1450

Alexandria, VA 22313-1450

tmb

March 2, 2007


SCOTT BADERMAN
SUPERVISORY PATENT EXAMINER